

REMARKS/ARGUMENTS

The Office Action mailed August 26, 2005 has been reviewed and carefully considered. Claim 2 is canceled. Claims 1, 3, 4, 6, 7, and 9 have been amended and claim 10 is added. Claims 1 and 3-10 are pending in this application, with claim 1 being the only independent claim. Claims 4-5 and 7-9 are withdrawn from consideration as being drawn to non-elected embodiments. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

In the Office Action mailed on August 26, 2005, claims 1-3 and 6 stand rejected under 35 U.S.C. §112, second paragraph, because "said support elements" in line 8 of claim 1 lacks antecedent basis. Independent claim 1 is amended to replace "said support elements" with --said support segments-- which has proper antecedent basis. In view of the amendments, the rejection of claims 1-3 and 6 as being indefinite should now be withdrawn.

Claim 1 stand rejected as anticipated by U.S. Patent No. 6,719,297 (Fenn).

Claims 2, 3, and 6 stand rejected under 35 U.S.C. §103 as being obvious over Fenn in view of U.S. Patent No. 1,181,618 (Smith).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 4 and 13 of Fenn.

Claims 2, 3, and 6 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 4 and 13 of Fenn in view of Smith.

Independent claim 1 is amended to include the limitations of dependent claim 2 and to further recite "said first and second tongues being radially equidistant from a center axis of said piston ring, said second tongue and said second opening forming a sealing surface between the ends of said piston ring for preventing damping fluid from flowing through the joint between the

top of the piston and the bottom of the piston". Support for the amendments to claim 1 are found in original dependent claim 2 and at Fig. 3 which shows that the second tongue extends circumferentially from the first tongue.

The combined teachings of Fenn and Smith fail to disclose, teach or suggest a piston ring having two tongues at a joint between the ends thereof wherein (1) the first and second tongues are radially equidistant from a center axis of said piston ring, and (2) the second tongue and the second opening form a sealing surface between the ends of said piston ring for preventing damping fluid from flowing through the joint between the top of the piston and the bottom of the piston.

Fenn discloses a piston ring with a single tongue 49 at one end which is received in a cutout 51 in the other end thereof (see col. 3, lines 34-39; and Fig. 3 of Fenn). The piston ring of Fenn includes supporting segments 39, 41 which are supported on the upper and lower sides of the piston (col. 3, lines 27-33). Furthermore, Fenn discloses that the tongue 49 includes retaining segments 53, 55 which are continuations of the supporting segments 39, 41 (see Fig. 4 and col. 3, lines 46-50). However, there is no teaching or suggestion for a second tongue in Fenn.

Smith discloses a piston ring C having ends A and B. A longitudinal main groove 1 is provided at an inner side of the ring at end A and an auxiliary groove 4 is formed at the end A at an outer side thereof. The end B of the piston ring C includes a main tongue 6 at an inner side and an auxiliary tongue 8 at an outer side thereof. At page 1, lines 91-99, Smith discloses that the main and auxiliary tongues prevent lateral displacement of the ends of the piston ring relative to each other. Smith requires that one of the tongues is on a radially inner side and the other is on a radially outer side because Smith uses the radially inner and outer arrangement of

the tongues to prevent lateral displacement of the ends of the piston. Accordingly, Smith fails to teach or suggest "the first and second tongues are radially equidistant from a center axis of said piston ring", as recited in independent claim 1.

Furthermore, Smith fails to disclose that the second tongue and second opening form a seal for preventing damping fluid from flowing through the joint between the top of the piston and the bottom of the piston. In contrast, Smith discloses that each tongue is arranged on either the inner side or the outer side of the tongue. Accordingly, both of the tongues are required to form a seal. Neither one of the tongues alone can be considered to disclose, teach, or suggest "said second tongue and said second opening forming a sealing surface between the ends of said piston ring for preventing damping fluid from flowing through the joint between the top of the piston and the bottom of the piston", as expressly recited in independent claim 1.

In view of the above amendments and remarks, it is respectfully submitted that independent claim 1 is allowable over Fenn in view of Smith.

Dependent claims 3, 6, and 10, each being dependent on independent claim 1, are deemed to be allowable for at least the same reasons expressed above with respect to independent claim 1, as well as for the additional recitations contained therein.

New claim 10 reads on the elected species of Fig. 3 and further recites "an entire axial extent of said second tongue is arranged in an area of said lateral surface between said support segments". Support for this limitation is found in Fig. 3 and the last three lines of paragraph 0018 of the specification. The combined teachings of Fenn and Smith fail to teach this limitation. Fenn fails to disclose a second tongue. Even if the supporting segments of Fenn were applied to the piston ring of Smith, the supporting segments would be arranged on the radially inner tongue of Smith which is the thinner tongue. The second or outer tongue Smith is

wider and would not be arranged between the support segments. Accordingly, dependent claim 10 is allowable for at least these additional reasons.


Furthermore, it is respectfully submitted that independent claim 1 as amended is a generic claim which reads on each of the embodiments of the dependent claims. Each of the withdrawn claims is dependent from independent claim 1 and therefore includes all of the limitations of claim 1. Accordingly, upon allowance of independent claim 1, consideration of withdrawn claims 4-5 and 7-9, is respectfully requested.

It is believed that no fees or charges are required at this time in connection with the present application. However, if any fees or charges are required at this time, they may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Respectfully submitted,

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